

Office Action Summary	Application No. 10/516,300	Applicant(s) PALUMBO ET AL.	
	Examiner WILLIAM T. LEADER	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt of the papers filed on September 29, 2009, is acknowledged. Applicant included copies of allowed claims from corresponding applications in other patent offices. These claims were discussed in a telephone interview on October 15, 2009.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-8, 10-12, 15, 17, 27-31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erb et al (US 5,433,797) in view of the Lowenheim text *Electroplating* and additionally in view of Biberbach et al (US 3,929,595) and Gonzalez et al (6,743,346) for the reasons of record.

4. New claim 34 recites passing single or multiple cathodic current pulses. Erb discloses electroplating by the application of pulsed current. See the abstract.

5. Claims 16, 18-25 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Erb et al (US 5,433,797) in view of the Lowenheim text *Electroplating* and additionally in view of Biberbach et al (US 3,929,595) and Gonzalez et al (6,743,346) as applied to claims 1-8, 10-12, 15, 17, 27-31, 33 and 34 above, and further in view of the admitted prior art for the reasons of record.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erb et al (US 5,433,797) in view of the Lowenheim text *Electroplating* and additionally in view of Biberbach et al (US 3,929,595) and Gonzalez et al (6,743,346) as applied to claims 1-8, 10-12, 15, 17, 27-31, 33 and 34 above, and further in view of Uzoh et al (US 7,378,004) for the reasons of record.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erb et al (US 5,433,797) in view of the Lowenheim text *Electroplating* and additionally in view of Biberbach et al (US 3,929,595), Gonzalez et al (6,743,346) and the admitted prior art as applied to claims 16, 18-25 and 32 above, and further of Hutkin (US 4,088,544) for the reasons of record.

Response to Arguments

8. Applicant's arguments filed September 29, 2009, have been fully considered but they are not persuasive. At page 2 of the Remarks, applicant correctly notes that the previous office action takes the position that "agitation rate normalized to electrode area is considered to pertain to the amount of agitation" (page 6 of the office action). Applicant argues that there is no source cited to evidence a basis for the conclusion that agitation rate normalized to electrode area expresses an amount of agitation. Applicant further argues that this conclusion is that of the Examiner and is therefore not a legitimate basis for rejection. Applicant's arguments are not convincing. As explained in MPEP 2111.01 the words of a claim must be given their plain

meaning unless such meaning is inconsistent with the specification. Applicant has not specifically defined the term "rate" in the specification. Consequently, "rate" is interpreted based on a standard dictionary definition. In Merriam-Webster's Dictionary of Law, 1996, "rate" is defined as "a quantity, amount or degree of something measured per unit of something else". Thus, the statement in the previous office action that agitation rate pertains to the amount of agitation is based on the standard dictionary definition.

9. Applicant states that the rejection seems to imply the claim requires a high rate of agitation and points out that based on page 5, lines 9-21 of the specification, circulation rates vary over a wide range of conditions. The rejection is not meant to imply that the claim requires a high rate of agitation – rather that a high rate of agitation is included within the scope of the claim.

10. At the bottom of page 10 applicant argues that none of the applied references mention obtaining grain refinement. In response to this argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

11. At page 11 of the Remarks applicant states that the EPO, German Patent Office and Canadian Intellectual Property Office all concluded that agitation rate normalized to electrode area is different from amount of agitation. Applicant refers to claims allowed by these patent offices, but does not point to any specific documentation from these patent offices including a statement related to their interpretation of agitation rate.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Leader/
November 17, 2009

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795